

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claim 7 contains allowable subject matter.

In the Official Action, the Examiner objects to the disclosure because the word “incline” is used in a manner inconsistent with common English, making the meaning unclear.

Merriam-Webster defines “incline” as to deviate from a line, direction, or course. Thus, the use of the terms “incline” and “inclined” include rotating and pivoting and is broad enough to also cover other motions, such as that described with regard to the change in direction of axis 08 in Figure 3. Therefore, Applicants respectfully submit that the use of the term “incline” is consistent with its common meaning. Furthermore, it is long settled that a patentee is free to be his own lexicographer and may use terms in a manner contrary to or inconsistent with their ordinary meaning.¹ The specification is clear as to the intended meaning of the terms “incline” and “inclined” particularly in view of the Figures.

Thus, the Examiner is respectfully requested to withdraw the objection to the disclosure.

In the Official Action, the Examiner rejects claims 1-31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the Examiner argues that the shaft recited therein is not clear because it is recited as part of the moving mechanism on line 7 thereof, as supporting the moving mechanism on line 13 thereof and the moving mechanism as being able to rotate around

¹ Markman v. Westview Industries, Inc., 52 F.3d 967, 979 (Fed. Cir. 1995 (en banc)), aff'd, 517 US 370 (1996).

the shaft. In response, claim 1 has been amended to clarify that that the basal portion supports the moving mechanism and the shaft portion is separately recited.

Further with regard to claim 1, the Examiner argues that the term “acting around” on lines 20 and 21 is not clear and that it is not clear how the instrument can be moved “around” the shaft. In response, claim 1 has been further amended to clarify that the medical instrument, supporting mechanism and moving mechanism rotate about the shaft portion.

With regard to claims 3, 16, 28 and 31, the Examiner argues that the same are indefinite because the claim limitations are dependent upon an arbitrary medical instrument that will determine the center of gravity and center of operation. In response, claim 1 has been amended to clarify that the counterweight **is located** on the second side of the moving mechanism **such that** a first rotation moment is smaller than a second rotation moment generated from the weights of the medical instrument and the supporting mechanism. The specification is clear that the counterweight is either changed or moved (collectively referred to in the claim as being located) such that a first rotation moment is smaller than a second rotation moment generated from the weights of the medical instrument and the supporting mechanism (see e.g., pages 10, lines 13-18, page 12, line 4 to page 16, line 1, particularly page 14, lines 18-25, page 20, lines 19-21 and page 22, lines 4-16. Claims 27 and 31 have been similarly clarified. Although not rejected, claim 30 has also been similarly clarified. The clarification of claims 1, 27, 30 and 31 (and thus, the claims depending therefrom), are fully supported in the specification and remove any indefiniteness from the claims (and those dependent therefrom).

With regard to claims 4, 5, 10, 11, 17, 18, 23, 24 and 29, the Examiner argues that the arms recited in such claims are not consistent with the specification. In this regard, the Examiner further argues that such claims appear to recite that the second arm appears to be

claimed as the shaft portion. In response, the Examiner is respectfully requested to reconsider such claims in light of amended claim 1. Furthermore, such claims clearly recite that the second arm is provided with the shaft portion, which is located between the one and the other ends of the second arm. Thus, the second arm (e.g., 16a) is provided with the shaft portion (e.g., 27).

With regard to claim 27, the Examiner argues that the term “the other end portion” is unclear. In response, claim 27 has been amended to clarify that each of the basal portion and rotating member have one end portion and an other end portion.

Further with regard to claim 27, the Examiner argues that the same is written where the shaft and rotating member are the same yet the counterweight is claimed as located on the rotating member when it appears to be on the lower arm of the parallelogram. Applicants disagree. Claim 27 recites a basal member having a rotating member (e.g., 27) at one end and a rotating member (e.g., parallelogram 16) where the shaft is located between the one end portion and other end portion of the rotating member. The counterweight is claimed as being located on the other end portion (which can be the lower arm 16c of the parallelogram 16) of the rotating member.

With regard to claim 30, the Examiner argues that the term “the moving means having a shaft portion and rotating the supporting means around the shaft portion” on lines 9 and 10 thereof fails to identify a structural relationship. In response, claim 30 has been similarly amended to claim 1 to separately recite the shaft portion.

Further with regard to claim 30, the Examiner recites that the limitation “the other side” on line 15 thereof has insufficient antecedent basis in the claim. In response, claim 30 has been amended to recite the proper antecedent basis for such term.

The amendments to the claims, as discussed above, are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of such amendments.

In view of the above, it is respectfully requested that the rejection of claims 1-31 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner objects to claims 9, 13, 15, 20, 22 and 26 under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 7.

Applicants respectfully disagree. While claims 9, 13, 15, 20, 22 and 26 recite similar limitations to that of claim 7, the claims differ because they depend from different claims and/or include the limitations of different/additional intervening claims. Specifically, claim 7 includes the limitations of dependent claim 6, intervening claims 2-5 and base claim 1. Claim 9 includes the limitations of dependent claim 8, intervening claims 2-4 and base claim 1. Claim 13 includes the limitations of dependent claim 12, intervening claims 2, 10, and 11 and base claim 1. Claim 15 includes the limitations of dependent claim 14, intervening claims 2 and 10 and base claim 1. Claim 20 includes the limitations of dependent claim 19, intervening claims 16 and 17 and base claim 1. Claim 22 includes the limitations of dependent claim 21, intervening claims 16 and 17 and base claim 1. Claim 26 includes the limitations of dependent claim 25, intervening claims 23 and 24 and base claim 1.

Accordingly, Applicants respectfully request that the rejection of claims 9, 13, 15, 20, 22 and 26 under 37 C.F.R. § 1.75 be withdrawn.

In the Official Action, the Examiner rejects claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,514,239 to Shimmura et al., (hereinafter "Shimmura").

In response, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 102(b) for at least the reasons set forth below. However, independent claims 1, 17 and 30 have been amended to clarify their distinguishing features.

Specifically, independent claims 1, 27 and 30 have been amended to recite that a joint portion in between a holding portion of a supporting mechanism and a moving mechanism is "a ball joint." Furthermore, the independent claims have been amended to clarify that the ball joint couples the moving mechanism and the supporting mechanism and is provided in a position shifted from a center of gravity of the holding portion on the supporting mechanism toward the moving mechanism. The dependent claims have also been amended, where necessary, to be consistent with amended independent claims 1, 27 and 30. The amendment to the claims is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the amendment to the claims.

In general, as shown in the attached drawing (Marked up Figure 4), moment of inertia (M) is generated by the weight of the endoscope in a state where the ball joint is provided between the holding portion of the supporting mechanism and the moving mechanism. Therefore, the holding portion is inclined relative to the moving mechanism. Thus, the holding portion is prevented from being inclined relative to the moving mechanism; that is, force ($W1\beta$) is exerted on the ball joint to compensate for the moment of inertia (see specification, page 33, line 18). The position of the counterweight is changed to exert such force ($W1\beta$) on the ball joint, thereby keeping balance of the medical instrument holding apparatus (see FIGS. 6 to 9). The attached marked up Figure is not being formally changed herein and is not being entered into the present application but is enclosed only for clarifying the above discussion.

With regard to the rejection of claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-31 under 35 U.S.C. § 102(b), a medical instrument holding apparatus having the features discussed above and as recited in independent claims 1, 27 and 30, is nowhere disclosed in Shimmura. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”² independent claims 1, 27 and 30 are not anticipated by Shimmura. Accordingly, independent claims 1, 27 and 30 patentably distinguish over Shimmura and are allowable. Claims 2-6, 8, 10-12, 14, 16-19, 21, 23-35, 28, 29 and 31 being dependent upon claims 1, 27 and 30, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-31 under 35 U.S.C. § 102(b).

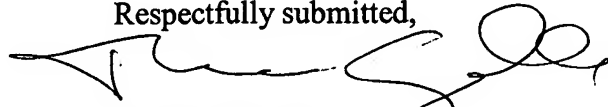
Furthermore, new claims 32-34 have been added to further define the patentable invention. New claims 32-34 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 32-34. Applicants respectfully submit that new claims 32-34 are at least allowable as depending upon an allowable base claim (1).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed

² Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', written over a horizontal line.

Thomas Spinelli
Registration No. 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Ste. 300
Garden City, New York 11530
(516) 742-4343

TS:jam
Encl. (Marked Up Figure 4)